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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,026	04/20/2004	Douglas F. Bateson	36287-4601	5972
28221 7590 04/13/2009 PATENT DOCKET ADMINISTRATOR LOWENSTEIN SANDLER PC 65 LIVINGSTON AVENUE ROSELAND, NJ 07068				
EXAMINER SHRESTHA, BLENDRA K				
ART UNIT 3691		PAPER NUMBER		
MAIL DATE 04/13/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/829,026

Applicant(s)

BATESON ET AL.

Examiner

BIJENDRA K. SHRESTHA

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 and 54-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 and 54-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 10/06/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-61 are presented for examination. Applicant filed an amendment on 01/08/2009 amending claims 1-2, 5, 20, 24-25, 28, 42, 46-49 and 54-61, canceling claims 50-53. After careful consideration of applicant's arguments and amendments, new grounds of rejections of claims necessitated by Applicant's amendment are established in the instant application as set forth in detail below. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1, 20, 24 and 42, as best understood, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a

statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In response to rejection of claims 1, 20, 24 and 42 being non-statutory under U.S.C. 101, the applicant amended the claims by adding language "implemented at least partially on a programmed computer" in the preamble without tying any other statutory class such as computer/ machine in the body of the claims. The limitation could be directed to a nominal tie to a machine which would not make the claim statutory. The applicant failed to overcome 101 rejections in the amendment filed on 01/08/2008 and the Examiner maintains the rejection of the claims under 101.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 20, 24, 28, 42, 47, 49, 55, 57, 59 and 61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claim languages "**automatically** adjusting the holdings....." is not described in the written description. After a thorough reading of the specification, the Examiner can locate at best support in the specification that describes "**periodically** adjusting the stabilized return.....". Appropriate correction is required.

Examiner interpreted the claim language as "periodically adjusting the return (computerized)..." for the application of the prior art.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 20, 24, 28, 42, 47, 49, 55, 57, 59 and 61 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant recite these claims as "a method implemented at least partially on a programmed computer...." without specifically pointing out which of the steps are implemented in the programmed computer and which are not. It is unclear to the Examiner which steps are carried out by the computer. Appropriate correction is required.

Examiner interpreted the method as "computerized method or computer implemented method" and accordingly such prior art are used in the rejection of claims,

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-49 and 54-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koppes et al., U.S. Patent No. 5,926,792 (reference A in attached PTO-892) in view of Petzal (Pensions & Investments) (reference U in attached PTO-892) further in view of Treyner, U.S. Patent No. 7,143,061 (reference B in attached PTO-892).
5. As per claim 1, 20, 24 and 42, Koppes et al. teach a method for coordinated investment, the method comprising:

Providing / receiving a stabilized return on holdings of fluctuating return assets that are held by an insurance carrier account (see column 2, lines 53-67 to column 3, lines 1-4; column 4, lines 59-67; where Stable value Protected Funds smooth the returns of investments in separate accounts of life insurance company).

Providing/receiving a second return (see column 2, lines 66-67 to column 3, lines 1-4; where Stable Value Protected Investment provides second returns).

Koppes et al. do not teach the method where the second return is substantially based on value of an established index and value of a notional investment.

Petzel teaches the method where the second return is substantially based on value of an established index and value of a notional investment and receiving a payment tied to an established rate (Petzel, page 1, last two paragraph to page 2, first paragraph; where second return is based on \$ 100 million notional value investment in

S&P 500 index for total return swap; page 2, paragraph 3-5; where manager earns LIBOR + 1.5% and 15% return on S&P 500 while it pays LIBOR 5% to swap counterparty; if S&P 500 declines, the manager earns LIBOR +1.5% and negative return (-10%) and pays 5% to swap counterparty).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow the method where the second return is substantially based on value of an established index and value of a notional investment of Koppes et al. because Petzel teaches that inclusion of these features would enable to create alpha and transport alpha onto the target by using swap contract (Petzel, page 1, abstract).

Koppes et al. do not teach automatically adjusting the holdings of fluctuating return assets in response to a change in the second return, wherein the holdings are increased when second return exceeds the established rate and holdings are decreased when the established rate are exceeds the second return.

Treynor teaches the method of adjusting the holdings of fluctuating return assets in response to a change in the second return (Treynor, Fig. 2; abstract).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow the method of adjusting the holdings of fluctuating return assets in response to a change in the second return of Koppes et al. because Treynor teaches that inclusion of these features would enable to maintain a portfolio that is time diversified in the sense the absolute risk associated with the portfolio stays approximately constant over time (Treynor, page 1, lines 43-48).

6. As per claim 2-7 and 25-30, Koppes et al. in view of Petzel further in view of Treynor teach claim 1 as described above.

Koppes et al. do not teach a method comprising established rate is LIBOR plus a percentage; the percentage is a spread; receiving LIBOR plus a percentage is linked to providing the second return; established rate is LIBOR minus a percentage; the percentage is a spread; and receiving LIBOR minus a percentage is linked to providing the second return.

Petzel teaches a method comprising established rate is LIBOR plus a percentage; the percentage is a spread; receiving LIBOR plus a percentage is linked to providing the second return; established rate is LIBOR minus a percentage; the percentage is a spread; and receiving LIBOR minus a percentage is linked to providing the second return (Petzel, page 2, paragraph 3-5; where manager earns LIBOR + 1.5% and 15% return on S&P 500 while it pays LIBOR 5% to swap counterparty; if S&P 500 declines, the manager earns LIBOR +1.5% and negative return (-10%) and pays 5% to swap counterparty).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow a method comprising established rate is LIBOR plus a percentage; the percentage is a spread; receiving LIBOR plus a percentage is linked to providing the second return; established rate is LIBOR minus a percentage; the percentage is a spread; and receiving LIBOR minus a percentage is linked to providing the second return of Koppes et al. because Petzel teaches that inclusion of these

features would enable to investment manager to generate alpha such that final outcome is target benchmark return plus the alpha (Petzel, page 2, paragraph 6, last sentence).

7. As per 8-9, and 31-32, Koppes et al. in view of Petzel further in view of Treynor teach claim 1 as described above. Koppes et al. further teach the method comprising receiving a fee linked to providing the stabilized return (see Fig. 12, step 1220; column 3, lines 1-4; column 4, lines 65-67); and

the insurance carrier account is a separate account (see column 4, lines 59-61).

8. As per claim 10-12 and 33-35, Koppes et al. in view of Petzel further in view of Treynor teach claim 1 as described above.

Koppes et al. do not teach the method wherein the second return is a total return swap on the established index, and based on the notional investment; the second return is a futures contract on the established index, and based on the notional investment; and the second return is a forward contract on the established index, and based on the notional investment.

Petzel teaches the method wherein the second return is a total return swap on the established index, and based on the notional investment; the second return is a futures contract on the established index, and based on the notional investment; and the second return is a forward contract on the established index, and based on the notional investment (Petzel, page 1, paragraph 1 and last two paragraph; page 2, paragraphs 1-3).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow the method wherein the second return is a total return

swap on the established index, and based on the notional investment; the second return is a futures contract on the established index, and based on the notional investment; and the second return is a forward contract on the established index, and based on the notional investment of Koppes et al. because Petzel teaches that inclusion of these features would enable to create alpha and transport alpha onto the target by using swap contract (Petzel, page 1, abstract).

9. As per claim 13-16, 19 and 36-39, Koppes et al. in view of Petzel further in view of Treynor teach claim 1 as described above.

Koppes et al. do not a method wherein adjusting the holdings of fluctuating return assets occurs on a periodic basis; the periodic basis is substantially every month; the periodic basis is substantially every quarter; adjusting the holdings of fluctuating return assets in response to a change in the notional investment; and an insurance carrier holding the insurance carrier account adjusts the holdings of fluctuating return assets.

Treynor teaches a method wherein adjusting the holdings of fluctuating return assets occurs on a periodic basis; the periodic basis is substantially every month; the periodic basis is substantially every quarter; adjusting the holdings of fluctuating return assets in response to a change in the notional investment; and an insurance carrier holding the insurance carrier account adjusts the holdings of fluctuating return assets (Treynor, Figs. 2-5).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow a method wherein adjusting the holdings of fluctuating return assets occurs on a periodic basis; the periodic basis is substantially every month;

the periodic basis is substantially every quarter; adjusting the holdings of fluctuating return assets in response to a change in the notional investment; and an insurance carrier holding the insurance carrier account adjusts the holdings of fluctuating return assets of Koppes et al. because Treynor teaches that inclusion of these features would enable to maintain a portfolio that is time diversified in the sense the absolute risk associated with the portfolio stays approximately constant over time (Treynor, page 1, lines 43-48).

10. As per 17-18 and 40-41, Koppes et al. in view of Petzel further in view of Treynor teach claim 1 as described above. Koppes et al. further teach the method wherein a stable value provider provides the stabilized return; and a stable value provider provides the second return (see column 2, lines 59-67 to column 3, lines 1-4).

11. As per 21-23 and 43-45, Koppes et al. in view of Petzel further in view of Treynor teach claim 20, 42 as described above. Claims 21-23 are rejected under same rational as claims 13-16 as described above.

12. As per claim 46-49, Koppes et al. teach a system for coordinated investment (see Fig. 1), the system comprising:

means for providing/receiving a stabilized return on holdings of fluctuating return assets that are held by an insurance carrier account (see column 2, lines 53-67 to column 3, lines 1-4; column 4, lines 59-67; where Stable value Protected Funds smooth the returns of investments in separate accounts of life insurance company);

means for providing/receiving a second return (see column 2, lines 66-67 to column 3, lines 1-4; where Stable Value Protected Investment provide second returns).

Koppes et al. do not teach that the means for providing a second return is substantially based on value of an established index and value of a notional investment and means for receiving payment tied to an established rate.

Petzel teaches a means where the second return is substantially based on value of an established index and value of a notional investment (Petzel, page 1, last two paragraph to page 2, first paragraph; where second return is based on \$ 100 million notional value investment in S&P 500 index for total return swap) and means for receiving payment tied to an established rate (page 2, paragraph 3-5; where manager earns LIBOR + 1.5% and 15% return on S&P 500 while it pays LIBOR 5% to swap counterparty; if S&P 500 declines, the manager earns LIBOR +1.5% and negative return (-10%) and pays 5% to swap counterparty).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow a means where the second return is substantially based on value of an established index and value of a notional investment and receiving payment tied to an established rate of Koppes et al. because Petzel teaches that inclusion of these features would enable to create alpha and transport alpha onto the target by using swap contract (Petzel, page 1, abstract).

Koppes et al. do not teach a means for adjusting the holdings of fluctuating return assets in response to a change in the second return, wherein the holdings are

increased when second return exceeds the established rate and holdings are decreased when the established rate are exceeds the second return.

Treynor teaches a means adjusting the holdings of fluctuating return assets in response to a change in the second return, wherein the holdings are increased when second return exceeds the established rate and holdings are decreased when the established rate are exceeds the second return (Treynor, Fig. 1 and 2; abstract; column 6, lines 23-44).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow a means for adjusting the holdings of fluctuating return assets in response to a change in the second return, wherein the holdings are increased when second return exceeds the established rate and holdings are decreased when the established rate are exceeds the second return of Koppes et al. because Treynor teaches that inclusion of these features would enable to maintain a portfolio that is time diversified in the sense the absolute risk associated with the portfolio stays approximately constant over time (Treynor, page 1, lines 43-48).

13. As per claim 54-57, Koppes et al. in view of Petzel further in view of Treynor teach system and method for providing/receiving a stabilized return in coordinated investment as described in claims 1-49 as described above.

The recitation of claims 54-57 claims execution of method/system using computer system and computer executable software code. Examiner notes that reference Koppes et al. (see Fig. 1; column 6, lines 44-67), Petzel, and Treynor (see

Fig.1; column 23-32) are capable of meeting claims limitation using computer system, computer readable media and computer executable software code.

14. As per claim 58-61, Koppes et al. in view of Petzel further in view of Treynor teach system and method for providing/receiving a stabilized return in coordinated investment as described in claims 1-57 as described above. Koppes et al. further teach a programmed computer for coordinated investment), comprising:

a memory having at least one region for storing computer executable program code; and a processor for executing the program code stored in the memory (see Fig. 1; Digital Storage Means (12), Central Processing Unit (6);

wherein the program code comprises:

code to provide a stabilized return on holdings of fluctuating return assets that are held by an insurance carrier account; code to provide a second return, where the second return is substantially based on value of an established index and value of a notional investment (see column 7, lines 53-67; where code to provide stabilized return on holding and other software can be stored for the method and system described in claim 1-49 described); code to receive a payment tied to an established rate (page 2, paragraph 3-5; where manager earns LIBOR + 1.5% and 15% return on S&P 500 while it pays LIBOR 5% to swap counterparty; if S&P 500 declines, the manager earns LIBOR +1.5% and negative return (-10%) and pays 5% to swap counterparty); and

code to adjust the holdings of fluctuating return assets in response to a change in the second return, wherein the holdings are increased when second return exceeds the

established rate and holdings are decreased when the established rate are exceeds the second return (Treyner, Fig.1; column 23-32).

Response to Arguments

15. New grounds of rejections of the claims necessitated by applicant amendments are established in the instant application. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally, it is noted that KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under KSR, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention (Rationale A). Furthermore, under KSR, a claim would have been obvious if a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying the teachings of Boyd and Ovadia into the disclosure of Pentel and the results would have been predictable to one of ordinary skill in the art (Rationale D).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the applicant argument that motivation to combine bears no relationship to the claimed inventions and is not a feature of the claimed invention is not the requirement. The combination that would provide some advantage or some beneficial result would be sufficient (see MPEP2144, sub heading II). Examiner further notes that Applicant specification does describes "alpha capture" or "enhanced index fund" whose purpose is to capture opportunities in fixed income markets and add them to total returns in the equity market (specification, page 7, lines 21-23 to page 8, lines 1-2).

Conclusion

16. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon:

Clark et al. (U.S. Patent No. 7,376,609) teach maximization of a hedged investment budget for an index-linked insurance product.

Payne et al. (U.S. Patent No. 6,049,772) teach system to managing hedged investment for life insurance companies.

Payne (U.S. Pub No. 2003/0144947) teaches computer-based system for hedging and pricing customized basket exchange swaps.

Schoen et al. (U.S. Pub No. 2004/02255536) teach superstructure pool computer system.

Whaley et al. (U.S. Pub No. 2006/0100949) teach financial indexes and instruments based thereon.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571)

270-1374. The examiner can normally be reached on 7:00 AM-4:30 PM (Monday-Friday); 2nd Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691

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BKS/3691
04/01/2009

